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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,276	02/04/2004	Stefaan De Bondt	016782-0299	2068
22428 7590 11/28/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER GRAY, JILL M	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/771,276	Applicant(s) DE BONDT ET AL.	
	Examiner Jill M. Gray	Art Unit 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-31,34-36,39-45 and 47-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-31,34-36,39-45 and 47-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 4-31, 34-36, 39-45, 47-49, 52-63, 65 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soens 4,664,971 in view of applicants' disclosure on page 5, lines 21-26 of the specification, i.e. European Patent Publication EP 0953651 B1 (Marandel) and Everett 2,050,298 or Webber et al., 3,379,000 (Webber), for reasons of record. Note US 6,048,416 is an English equivalent of EP 0953651.

Soens discloses plastic articles, threads and grains for use in EMI shielding or antistatic plastic articles comprising a polymer matrix and stainless steel fibers having a diameter of more than 0.5 $\mu$ m, per claims 1, 31 and 36. See abstract, column 2, lines 20-25 and column 3, line 7. In addition, Soens teaches that the volume of fibers can vary between about 0.03% vol and about 0.5% vol as required by claims 4-8. See

column 2, lines 58-59. It should be noted that Soens also teaches fiber plastics composites wherein the %vol of the resin is within applicant's range as set forth in claims 34 and 39. See column 3, lines 64-67. Also, Soens teaches plastic articles having a thickness within the range of applicant's claims 9-10 (column 2, lines 42-43) and grains having a length within the range as claimed in claims 40-41 (column 4, lines 22-24). The polymer matrix can be a thermoset polymer or thermoplastic polymer of the type contemplated by applicants in claims 12-14, 35, and 42. See column 5, lines 26-30 and claim 6. Further, Soens teaches plastic articles that have a shielding effectiveness of at least about 25 dB, as required by claims 15-23. See column 2, lines 12-14. Soens teaches at column 3, lines 7-13 that stainless steel fibers formed by a method of bundle drawing as described in U.S. Patent No. 2,050,298 (Everett) or 3,379,000 (Webber) show particular suitable intrinsic conductive properties for his invention. Accordingly, Soens teaches the usage of bundle drawn stainless steel fibers, as required by applicants. Soens does not teach the specific composition of his stainless steel fibers or that his fibers satisfy the relationship of claims 1, 31, 33, 36, 38, and 47-49, the fracture strength standard deviation or strain at fracture required by claims 24-30.

Marandel teaches in the abstract stainless steel fibers having a diameter within the range taught by Soens and as required by applicants, said stainless steel fibers having a composition comprising iron and C, Mn, Si, Ni, Cr, Mo, Cu, N, S, and P, each component present in the amount contemplated by applicants in claims 1, 31 and 36, further teaching that the fibers can be coated with a metal such as copper (per claims 29-30) and that said composition satisfies the relationship as required by claims 1, 31,

33, 36, 38, and 49. In addition, Marandel teaches that his steel fibers have a strength of more than 2000Mpa as required by claim 26.

The use of stainless steel fibers in the formation of EMI shielding and antistatic plastic articles is well known in the art. The skilled artisan would have had a reasonable expectation of success of obtaining an EMI-shielding article with the incorporation of any stainless steel fibers known in the art as the conductive fibers of Soens. Though Soens is silent as to the specific stainless steel fibers used, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the stainless steel fibers of Soens, fibers of the composition and type taught by Marandel, with the expectation of a known component functioning in it's known manner. As to claims 24-25 and 27-28, since the stainless steel fibers of Marandel are of the same type as applicants, the examiner has reason to believe that properties such as the fracture strength standard deviation, strain at fracture standard deviation, strain at fracture, and diffusion at a depth of 100 nm are the same or similar to these properties contemplated by applicants. There is no factual evidence on this record to the contrary. Applicants are invited to provide such evidence. Regarding claim 11, this claim is drawn toward the size of the plastic article wherein changes in size ordinary are not a matter of invention in the absence of evidence to the contrary. Regarding claims 43-45, 58-63, 65, and 67, Soens teaches the desirability of bundle drawn stainless steel fibers. It would have been obvious to reduce the diameter of the stainless steel fibers and thereby modify the reduction deformation during routine experimentation commensurate with the desired finess of the steel fibers and as is known in the art,

evidenced by the teachings of Soens, Everett and Webber. Claims 52-57 are drawn to the dimensions of the article, thread and grain, wherein changes in size ordinarily are not a matter of invention.

Therefore, the combined teachings of Soens, Marandel '651, Everett and Webber would have rendered obvious the invention as claimed in present claims 1, 4-31, 34-36, 39-45, 47-49, 58-63, 65 and 67.

1. Claims 1, 4-5, 9-11, 13, 15-17, 21-30, 36, 39-45, 47-49, 52-53, 56-57, 61-63, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivas 5,904,980 in view of European Patent Publication abstract EP 0953651 (Marandel '651) for reasons of record, further in view of Soens 4,664,971 and Everett 2,050,298, both as applied above.

Rivas discloses EMI and ESD reinforced plastic materials comprising polymers and additive such as stainless steel fibers, per claims 1 and 36. See abstract. In addition, Rivas discloses that the polymer can be present in approximately 95% to 85% and the additive is present in amounts of 5% to 15%, as required by claims 4-5 and 39. See column 1, lines 42-43. The polymer can be a thermoplastic as required by claim 13 and the article can have a thickness within the ranges set forth by applicants in claims 9-10 and 40-41. See Example 1. Furthermore, the formations of Rivas have an EMI shielding effectiveness at or above 35 decibels, as required by claims 15-17 and 21-23. See column 6, lines 2-6. Rivas does not teach the specific composition of his stainless steel fibers or that his fibers satisfy the relationship of claims 1, 3, 30, 33, 36, 38, and

47-49, nor bundled matrix, the fracture strength standard deviation or strain at fracture required by claims 24-30.

Marandel, as set forth above, teaches in the abstract stainless steel fibers having a diameter within the range taught by Rivas and as required by applicants, said stainless steel fibers having a composition comprising iron and C, Mn, Si, Ni, Cr, Mo, Cu, N, S, and P, each component present in the amount contemplated by applicants in claims 1, 31 and 36, further teaching that the fibers can be coated with a metal such as copper (per claims 29-30) and that said composition satisfies the relationship as required by claims 1, 31, 33, 36, 38 and 47-49. In addition, Marandel teaches that his steel fibers have a strength of more than 2000MPa as required by claim 26.

The use of stainless steel fibers in the formation of EMI shielding and antistatic plastic articles is well known in the art. The skilled artisan would have had a reasonable expectation of success of obtaining an EMI-shielding article with the incorporation of any stainless steel fibers known in the art as the conductive fibers of Rivas. Though Rivas is silent as to the specific stainless steel fibers used, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the stainless steel fibers of Rivas, fibers of the type taught by Marandel, with the expectation of a known component functioning in its known manner. As to claims 24-25 and 27-28, since the stainless steel fibers of Marandel are of the same type as applicants, the examiner has reason to believe that properties such as the fracture strength standard deviation, strain at fracture standard deviation, strain at fracture, and diffusion at a depth of 100 nm are the same or similar to these properties contemplated

by applicants. There is no factual evidence on this record to the contrary. Applicants are invited to provide such evidence. Regarding claim 11, this claim is drawn toward the size of the plastic article wherein changes in size ordinary are not a matter of invention in the absence of evidence to the contrary. Regarding claims 43-45, Soens teaches at column 3, lines 7-13 that stainless steel fibers formed by a method of bundle drawing as described in U.S. Patent No. 2,050,298 (Everett) or 3,379,000 (Webber) show particular suitable intrinsic conductive properties for use in EMI shielding or antistatic plastic articles comprising a polymer matrix and stainless steel fibers. Accordingly, Soens and Everett teach bundle drawn stainless steel fibers, as required by applicants. It would have been obvious to reduce the diameter of the stainless steel fibers and thereby modify the reduction deformation during routine experimentation commensurate with the desired fineness of the steel fibers and as is known in the art, evidenced by the teachings of Soens, Everett. Regarding claims 52-53 and 56-57, these claims are drawn to the dimension of the article, and grain, wherein changes in size ordinarily are not a matter of invention.

Therefore the combined teachings of Rivas, Marandel, Soens and Everett would have rendered obvious the invention as claimed in present claims 1, 4-5, 9-11, 13, 15-17, 21-30, 36, 39-45, 47-49, 52-53, 56-57, 61-63, and 67.

### ***Response to Arguments***

2. Applicant's arguments filed October 31, 2007 incorporating arguments filed September 14, 2007 have been fully considered in the Office Action of October 10, 2007, and are reproduced below.



Applicants argue that with respect to claims 1 and 31, Marandel does not teach stainless steel fibers, rather Marandel only teaches a mono wire and that the rejection of the claims is based upon a fundamental misreading of a critical reference and thus a *prima facie* case of obviousness has not been established for this reason.

In this regard, one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references. *In re Young*, 159 USPQ 725 (CCPA 1968). Applicants are reminded that the prior art rejection is based upon the combined teachings of Soens and Marandel or Rivas and Marandel each further in view of Webber and/or Everett, wherein Marandel is relied upon for his teachings of a stainless steel wire having the same compositional makeup and substantially similar if not overlapping properties as that of the instant invention. Each of Soens and Rivas disclose plastic articles comprising a matrix material and bundle drawn stainless steel *fibers*, although silent as to the specific stainless steel composition. Said composition is known in the art as admitted by applicants in their specification. It would have been obvious to look to that which is already known. "Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Winslow*, 151 USPQ 48 (CCPA 1966). The fact that Marandel teaches one wire does not preclude the reasonable and inevitable conclusion that one of ordinary skill in this art would envisage more than one wire or applications requiring more than one wire. Everett and Webber each teach the formation of fine filaments wherein a plurality of wires are bundle drawn to form said filaments. The examiner is of the position that at the time the invention was made, the skilled artisan

would know how to take that which is known in this art, namely a stainless steel wire and the teachings of Everett and Webber, to achieve the predictable results of stainless steel *fibers*.

Applicants argue that with respect to dependent claims 43-45 and 49, the prior art fails to disclose or suggest a plastic article with stainless steel fibers of the composition recited in claim 1 that have undergone the requisite deformation  $\epsilon$  of at least 4.5 or 4.8 or 5.2, as recited in claims 43-45 or have an MI value that permits reduction with a deformation of at least 4.5, as recited in claim 49.

In this regard, it is noted that the stainless steel wire of composition C in Table 2 of Marandel has deformations within the instant claimed range. Applicants are reminded that “[a] reference may be relied upon for all that it would have reasonable suggested to one having ordinary skill in the art, including nonpreferred embodiments.” *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.) and “[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) and MPEP 2131.

Applicants argue that MPEP 2141 states that “to rely on a reference under 35 U.S.C. 103, it must be analogous prior art.” Applicants also argue that wire for tire reinforcement is not analogous to EMI-shielding/EDS, and that the tire arts are so far removed from the EDS/EMI-shielding arts that one versed in EDS/EMI-shielding would not have been motivated to look to the tire arts. Applicants further argue that there is no evidence that an artisan versed in EDS/EMI-shielding arts in the 200/2001 timeframe

would look to techniques (in Marandel) involved in the construction of tires and that a person of ordinary skill in the EDS/EMI Shielding art would not reasonably look to the tire field.

Agreeably to rely on a reference under 35 U.S.C. 103 it must be analogous prior art as stated in the MPEP. However, the MPEP also states that in order to rely on a reference as a basis for rejection of an applicants' invention, the reference must either be in the field of applicants endeavor, it not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a). First, while USPTO classification is not always reliable, it can show some evidence of "nonanalogy" or "analogy". In the instant case, it is noted that the English equivalent 6,048,416 is not classified nor cross-referenced in the "tire field". Rather, this patent has been classified in areas related to metal treatment and compositions. The skilled artisan concerned with stainless steel fibers having a substantially homogenous composition and/or equal properties over the length of the wire would have been reasonable motivated to look in those areas related to metal compositions and/or metal treatment. Secondly, it would appear that applicants have oversimplified the teachings of Marandel. Marandel would have been considered reasonably pertinent to the particular problem with which the present inventors was concerned because the matter with which it deals, namely, steel wire of specific composition that results in certain deformation characteristics logically would have commended itself to applicants' attention in consideration of his problem. Third, the examiner notes that applicants have acknowledged in the specification that prior art pertinent to his invention includes

“steel of a composition known from EP953651” (Marandel). It is the examiner’s position that applicants may not now argue that Marandel is non-analogous art. *In re Schriber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

Applicants argue that Marandel/Hauser teaches away from the recitation in the claims regarding the relationship of the composition of the stainless steel – that the relationship be less than or equal to  $-60$ . Applicants further argue that claim 1 recites a value of MI/JM that is less than or equal to  $-60$  which is outside the express range identified in Hauser and one of ordinary skill in the art would not have been motivated to modify Marandel to have a MI/JM value of less than or equal to  $-60$ , as Marandel expressly teaches that values below  $-55$  are to be avoided.

In this regard and as set forth previously, “[a] reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments.” *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.) and “[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) and MPEP 2131.

Applicants argue that as noted previously, Marandel teaches a mono wire and a mono wire is diametrically opposite of bundle drawn fibers. Applicants further argue that Marandel would have discouraged the ordinary artisan from modifying Marandel to obtain a bundle as claimed, and further, the ordinary artisan would have been

discouraged from considering the teachings of Marandel to obtain bundle drawn stainless steel fibers having an equivalent diameter as claimed.

In this regard, applicants are again reminded that one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references. *In re Young*, 159 USPQ 725 (CCPA 1968). Applicants are again reminded that the prior art rejection is based upon the combined teachings of Soens and Marandel or Rivas and Marandel each further in view of Webber and/or Everett, wherein Marandel is relied upon for his teachings of a stainless steel wire having the same compositional makeup and substantially similar if not overlapping properties as that of the instant invention. All of the claimed components were known in the prior art and one skilled in the art could have combined the components by known methods with no change in their respective functions, and this combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Applicants argue that a "patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103."

Agreeably a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. However, the mere fact the references relied on by the examiner fail to evince an appreciation of the problem identified and solved by applicants is not, standing alone, conclusive evidence of the nonobviousness of the claimed subject. The

references may suggest doing, what an applicant has done even though workers in the art were ignorant of the existence of the problem. *In re Gershon*, 152 USPQ 602 (CCPA 1967).

Applicants argue that MPEP 2143.01, subsection 3 specifically states that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Applicants further argue that the Office Action fails to provide sufficient motivation to modify either of Soens or Rivas to arrive at the invention of the claims and basically relies on the alleged case by which the cited references may be combined/modified.

Agreeably the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. However, the examiner disagrees that there is not sufficient motivation to combined the cited prior art references. For reasons set forth above and incorporated herein, the combined teachings of Soens, Marandel, Everett and Webber or Rivas, Marandel and Everett would have provided a suggestion to the skilled artisan for the instant claimed plastic articles.

Applicants argue that the Office Action is completely devoid of any argumentation that motivation was present in the prior art and that the alleged motivation is conclusory and, in fact, relies on applicants' disclosure, which is impermissible hindsight. Applicants further argue that while it is permissible under certain circumstances to use teachings in the "background section" of an application to teach missing elements of the

prior art, it is impermissible to use applicants' application against them for motivation to combine or modify references.

Applicants' arguments have been noted. Nonetheless, it is the position of the examiner that the differences between the subject matter claimed and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. It is not necessary that either Soens, Rivas, Marandel, Everett, or Webber expressly suggest the changes or improvements that applicants have made. All that is required to show obviousness is that the applicant "make his claimed invention merely by applying knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Sheckler*, 168 USPQ 716 (CCPA 1971); *In re Winslow*, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151 USPQ 48, 50-51 (1966).

Applicants argue that MPEP 2143.01(V) states that the "proposed modification cannot render the prior art unsatisfactory for its intended purpose." Applicants further argue that as detailed previously modifying the MI/JM value to be -60 or less would render the device of Marandel/Hauser inoperable due to the low quantity of martensite formed the insufficient tensile strength, and thus the proposed modifications to the cited references violate yet additional provision of the MPEP.

Agreeably, the prior art discloses a preference for wires between -55 to -30 because of the tensile strength cannot achieve high values above 2200MPa. However, as set forth previously, the prior art clearly discloses the instant invention without

modifications. Note stainless steel wire of composition "C" in Table 2, which discloses a stainless steel composition having the same metals as applicants, wherein said metals are present within the amounts as claimed, and the resulting wire having deformations also within the instant claimed range. As set forth previously, a nonpreferred embodiment does not negate the clear disclosure of stainless steel wire "C" in Table 2 of the prior art.

Applicants argue that with respect to dependent claims 43-45 and 49, the Office Action ignores the express teachings of Marandel/Hauser, which teaches away from reductions with a deformation of at least 4.5.

In this regard, the examiner's position is as set forth previously and incorporated herein. More specifically, all of a reference must be evaluated for all that it fairly suggests, including nonpreferred embodiments. Note MPEP 2123 and 2145. Furthermore, a nonpreferred embodiment of Marandel/Hauser does not negate the clear disclosure of stainless steel wire "C" in Table 2 of the prior art wherein said wire has the same composition as claimed and deformation values within the instant claimed range. A known or obvious wire does not become patentable simply because it was described as somewhat inferior to others produced for the same use. *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Applicants argue that in light of the teachings of Marandel/Hauser against deformations of at least 4.5, it would not have been obvious to one of ordinary skill in the art to modify the prior art references to provide a plastic article with stainless steel fibers of the composition recited in claim 1 that have undergone a deformation of at



least 4.5 or that have an MI value that permits a reduction with a deformation of at least 4.5.

In this regard, for the reasons set forth above and incorporated herein, the examiner's position remains that when considered as whole, the combined teachings in the prior art would have rendered obvious the instant claimed plastic article.

Applicants argue that the Office Action has not provided motivation for why one of ordinary skill in the art would have been motivated to modify the deformations disclosed by Marandel/Hauser through routine experimentation and that only result-effective variables can be optimized through routine experimentation, further arguing that the Office Action has not shown how deformation is recognized as a result-effective variable in the cited prior art or that the determination of an optimum deformation range could be conducted through routine experimentation.

Applicants are again reminded that Marandel/Hauser fully discloses a stainless steel wire, having the same composition as claimed in present claim 1, with deformations within the instant claimed range, or more specifically, Marandel/Hauser teaches deformation of 4.49, 4.63, and 6.24. That which is fully disclosed in a prior art reference does not necessarily require modification of said reference to achieve what has already been taught. Applicants are again reminded that nonpreferred embodiments in a reference do not preclude clear disclosure in said reference. Applicants also are again reminded against attacking the references individually when the prior art rejection is based upon a combination of references, namely, Soens, Everett, Webber, and Marandel.

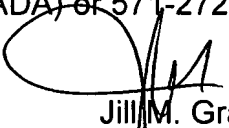
Therefore, when considered as a whole, the examiner's position remains that the combined teachings of Soens, Marandel, Everett, and Webber or alternatively, Rivas, Marandel and Everett would have rendered obvious the invention as claimed in the present claims.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jill M. Gray  
Primary Examiner